UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,908	11/28/2000	Casey J. Pelkey	723-987	7830

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EXAMINER
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ART UNIT	PAPER NUMBER
3713	12

DATE MAILED: 02/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _15 December 2003_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-52_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-52_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Examiner acknowledges receipt of amendment on 12/15/03. The arguments set forth in

the response are addressed herein below.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

Claims 39-45 and 48-51 are rejected under 35 U.S.C. 101 because the claimed invention

is directed to non-statutory subject matter. Applicant is currently claiming software, or merely

computer instructions for performing a certain number of computer actions. Computer

instructions per se are considered non-statutory subject matter. However computer instructions

per se, embodied in tangible storage mediums are considered statutory. Applicant has certain

embodiments that are to be included in tangible storage mediums as seen in claims 46-47 and 52,

but the embodiment of claims 39-45 and 48-51, lacking this storage mediums are classified as

non-statutory subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section
> 102 of this tifle, *if* the differences between the subject matter sought to be patented and the prior art are such that the
> subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill
> in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention
> was made.

Claims 1-13, 16-3 1, 34-38, 39-50 are rejected under 35 U.S.C. 103(a) as being

unpatentable over First Internet Backgammon Server 1994 (FIBS) in view of Instant Messaging

Guide 1996 (IMG) in view of US Patent No. 5,960,173 to Tang et al. (Tang). In re claims, 1-3,

and 29-30, FIBS teaches an Internet connected server (Pg. 1, What is FIBS?), a plurality of

people connecting to the Internet server indicating at least two video game systems configured to

connect (Pg. 1, What is FIBS?), communicating status data of activity through watching plays

(Pg. 2, Player status), session data on status of users concerning their ratings and availability (Pg.

2, Player status), and the session data is available to anyone logged into the system regardless of

game play. FIBS does not teach creating user defined buddy lists. IMG teaches creating user

definable buddy lists so that a user can easily ascertain whether a defined user is available (Pg.

3). FIBS and IMG are related in that both facilitate network realtime messaging between

available users. IMG is an updated chatting program having features that are highly desirable to

most users attempting to use real-time chatting, therefore providing motivation to include these

features in FIBS. Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to modify FIBS to include a user definable buddy list as taught by

IMG so that a user can easily and quickly determine is their buddies are available. Tang is further

evidence that monitoring users on different computer using different applications was well

known in conjunction with providing user communication. Tang teaches a networked computer

system that monitors a plurality of users engaged in various computer activities and provides

current user status to all those involved in the various computer activities (Abstract). Tang's

system provides a desirable mechanism as a way for people to initiate a conversation or other

encounters with which they would like to interact (2:36-39). Tang also teaches tracks and allows

users to be engaged in various different computer programs (3:46-50), is updated as to show

current user engagement (4:55-59), provides a visual or other cue to users of the system that

people are available or unavailable (4:59-64), workers could be connecting and accessing various

web computers (5:12-59), users can control the degree of monitoring the system can employ

(7:1-14), the users can communicate via text messaging (8:1-3), a user can control his/her own

availability to other users (12:62-13:9), and users and predefined lists are defined by those

belonging to a group (2:28-39). One would be motivated to use the features taught by Tang

because the system is a desirable mechanism for network communication. Thus it would have

been obvious to one of ordinary skill in the art at the time the invention was made to modify

FIBS in view of IMG to use the system taught by Tang, so that the existing game communication

is enhanced with other known desirable features in a network communication system.

In re claim 2, FIBS teaches indicating status data of whether a player is online (Pg. 2,

Player status) and where the ability to send and receive message is inherent once online.

In re claims 3 and 31, FIBS teaches indicating status data of whether a player is online

(Pg. 2, Player status) and setting an indicator of status to 'not ready', which indicates a player is

online, but not ready to communicate or play a game.

In re claim 4, IMG discloses Internet chatting programs and their features, where a user

can customize a message to indicate anything the users wants to share with other users (Page 2,

Message Central).

In re claim 5, FIBS teaches storing player profiles as rating, experience, and game drop

ratings (Pg. 2, Player status; Pg. 3, Droppers).

In re claims 6 and 19, FIBS in view of IMG teaches blocking access to a users profile as

one of the message indicators (Page 2, Features).

In re claim 7, FIBS teaches an administrator blocking a user's access effectively affecting

the accessibility of a user profile.

In re claim 8, FIBS in view of IMG in view of Tang teach the claimed limitations as discussed above, but do not teach communicating to a user the buddy list memberships a user is active in. IMG teaches providing security measures to let users know what buddy lists they belong to through authorization techniques. A first user cannot be added to a buddy list of a second user unless the first user provides authorization through a notification request from a second user (Pg. 6, ICQ (I Seek You)). One would be motivated to modify FIBS in view IMG to add the buddy list membership identifier, to increase system security, and it bars people you don't want to talk to from instant messaging you. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify FIBS in view of IMG to further add a buddy list membership identifier as part of system software for security purposes.

In re claim 9, FIBS in view of IMG in view of Tang teach the claimed limitations as discussed above, where denying authorization to add one to a buddy list is analogous to a request for deleting that user's name from the buddy list.

In re claims 10-13 and 46, FIBS in view of IMG in view of Tang teaches the claimed limitation as discussed above in addition to the chat software contemporaneously with the game, but does not teach the application stored on a portable memory medium. However, as is old and well known in the computing arts, storing programs for portability on optical, magnetic, or semiconductor medium can be accomplished and are all considered art recognized equivalents. One would be motivated to store the game program on a portable memory medium for distribution to a wider audience that does not have high bandwidth network access, often a limitation for downloading large files. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify FIBS in view of IMG in view of Tang to include the game software on a portable memory medium for greater access by the public, therefore increasing game participation and distribution.

In re claim 16, FIBS teaches the game used the Internet for communication as described by the game server title.

In re claims 17-18 and 34-36, FIBS teaches a user registration routine in the messaging and game software, where the registration will create a user profile (Pg. 2, Username and password).

In re claims 20-21, Tang teaches the ability to add customized images to a user profile as discussed above.

In re claim 22, FIBS teaches having a buddy list routine for creating buddy list as described by the ability to find out who is currently logged on (Pg. 2, Player status).

In re claim 23-24, Tang teaches providing alerts during a sign-on or sign-off event teach as discussed above.

In re claim 28, FIBS teaches the portable memory storage as discussed above, and furthermore teaches the game executed on a computer device. As a computer would typically have inputs for the various memory mediums, it would have been obvious to one of ordinary skill to have connectors connecting the drives that read the memory medium to the computer for necessary read/write operations.

In re claim 25, FIBS teaches an alert when a message arrives, as the message itself is the alert, for example, when inviting a player to a game or chaffing (Pg 2, Player status, Chatting).

In re claims 26, and 37-38, FIBS in view of IMG in view of Tang teach the claimed limitations as discussed above, but does not teach an auto start and auto logging routine for the game program. IMG teaches an auto-start and logging routine when starting a users computer (Pg. 3, The Good and the Bad). One would be motivated to modify FIBS in view of IMG in view of Tang to include the auto-start and logging feature to alleviate a user from manually starting the game/messaging program, where it is obvious to automate a manual process. Therefore, it

would have been obvious to one of ordinary skill in the art at the time the invention was made to modify FIBS in view of IMG in view of Tang to include the auto-start and logging feature, to have the game software program instantly ready for a user to participate, adding increased play time.

In re claim 27, FIBS in view of IMG in view of Tang teach customizing a message describing a user's activity as discussed in claim 4, which would also allow a user to log that particular activity the user is engaged in on the computer system.

In re claims 41-43, Tang teaches providing any number of methods of communication with other users on the system, which are all provided through the application framework (8:30-64). Prompting a user that another is attempting communication is inherent to providing the mechanism to communicate.

In re claim 44, Tang teaches a central repository for storing user desired settings (11:55-12:30).

In re claims 47 and 52, FIBS in view of IMG in view of Tang by nature require the use of a storage device for storing instructions for software, else the system would be inoperable.

In re claim 51, Tang teaches that the communication server supports any number of communication mediums between system users including video, audio, text, and email (8:52-64).

Claims 14-15 and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over FIBS in view of IMG in view of Tang and further in view of Best '073. FIBS in view of IMG in view of Tang teach the claimed limitations as discussed above, but do not teach the game system comprising a hand-held or video game console. Best teaches a communicative game system using a handheld game system and a video game system to play a (Fig. 9), both of which can accept portable memory storage mediums (9:63-10:14). FIBS in view of IMG in view of Tang and Best are related as game system played by multiple players, facilitating communication

between participating players where one would have been motivated to use the game video game console or the handheld game system to play the game, as a specialized hardware for a singular purpose is less expensive than employing the use of a general purpose computer. A general-purpose computer is more expensive due to the need for greater functionality, wherein the handheld system or the console system need only serve the purpose set forth by the game constraints. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made modify FIBS in view of IMG in view of Tang to use either the handheld or video console game system, to help reduce game costs, therefore increasing marketability, player usage.

Response to Arguments

Applicant's arguments filed 12/15/03 have been fully considered but they are not persuasive. Applicant has added new claims, and also provided arguments regarding proper application of the references. In regard to the new and pending claims, Examiner has included additional teachings that show long known features of communication programs and how the integration of this software with other software to show what actions users were performing on their computers. As such, the Application stands rejected.

Citation of Pertinent Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent No. 5,880,731 to Liles et al. teaches a network chatting program.

US Patent No. 6,677,968 to Appelman teaches a network chatting program with features of user definable on-line co-user lists.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Aaron L Enatsky whose telephone number is 703-305-3525. The

examiner can normally be reached on 8-6 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Teresa Walberg can be reached on 703-308-1327. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

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ALE

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